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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,349	03/18/2004	Jacqueline Erlebacher	29617/SH009A	5816
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MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER WALCZAK, DAVID J	
			ART UNIT 3751	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,349

Applicant(s)

ERLEBACHER ET AL.

Examiner

David J. Walczak

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3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45, 47-55 and 57-78 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39 and 44 is/are allowed.
- 6) ☒ Claim(s) 45, 49-54 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-6,8,13,17,19,22,23,25-38,40-43,47,48,55 and 57-77.

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The terms/limitations "side wall", "rear wall" and "enclosing a rear end" (claim 78) do not have antecedent basis in the specification.

Claim Rejections - 35 USC § 112

Claim 78 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. An antecedent basis for "the sealed end" (line 8) should be defined (it appears that "sealed end" should be --rear end--).

Claim Rejections - 35 USC § 102

Claims 45 and 49-52 remain under 35 U.S.C. 102(b) as being anticipated by Ross. In regard to claim 45, Ross discloses a sheet material cartridge for use with a writing instrument comprised of a dispenser base 12 adapted for removable attachment to the writing instrument 30, a dispenser housing 24 coupled to the dispenser base defining an interior receptacle, an opening 26 in communication with the interior receptacle and sheet material comprising a plurality of sheets 18 (as individual sheets are ripped from the roll, the Ross device is considered to include a "plurality of sheets")

disposed in the housing interior receptacle wherein the sheet material has a thickness smaller than the width of the opening to allow the sheet material to pass therethrough wherein the base 12 comprises a "nub" (the lower end of the base defines a "nub") wherein the nub is adapted to be releasably engaged in a recess in the writing instrument, i.e., as the writing instrument is not considered part of the claimed combination, the nub only needs to be capable of being received as claimed. Upon a writing instrument having an appropriately sized recess therein, the nub would be sized as claimed. Further, the housing 24 includes a rear surface having a recess therein (which receives elements 16, 17) wherein the recess is "sized to releasably engage a nub from a writing cap", i.e., as the writing cap and nub thereon are not considered part of the claimed combination, the recess needs only to be capable of receiving such a nub. Upon removal of element 16, and upon a cap having an appropriate size, the recess would be "sized" as claimed. Lastly, the nub 12 of the dispenser base has a shape that is complementary to the recess in the housing 24 "such that the sheet material cartridge could be stacked with a similarly configured second sheet material cartridge, i.e., the outer diameter of nub 12 is sized such that element 12 slides within housing 24 (see Figure 1). Accordingly, the nub is complementary to the recess in housing 24 so that the cartridge "could be stacked" with another cartridge (upon removing elements 16 and 17 from the end of housing 24, a second nub 12 could be slid therein since the outer diameter of nub 12 matches the inner diameter of housing 24). In regard to claim 49, the dispenser housing 24 is releasably coupled to the dispenser base 12. In regard to claim 50, the interior receptacle is generally cylindrical

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and the sheets are arranged as a roll of sheet material. In regard to claim 51, the dispenser base includes an inner shell 11 sized for insertion into the housing and an inner surface sized to receive the roll of sheet material wherein the inner shell includes an end cover 16 attached to one end thereof and wherein the inner shell is partially cylindrical and has opposed first and second ends which define an inner slot 14 sized to receive the sheet material. In regard to claim 52, the housing opening 26 is formed as an outer slot in register with the inner slot 14 (see Figure 2).

Claim 78 is rejected under 35 U.S.C. 102(b) as being anticipated by Connors. Connors discloses a writing instrument with a sheet material dispenser comprised of a writing instrument body portion 14 having a side wall and a rear wall 16 including a recess wherein the side and rear walls enclose a rear end of an ink reservoir (element 14 defines an "ink reservoir"), a writing tip 22 carried by the body portion a dispenser base adapted for attachment to the body portion wherein the base includes a nub (the lower threaded section of element 12 that is received in the recess of element 16 defines a "dispenser base including a nub") disposable in the recess in the rear wall, a dispenser housing 12 coupled to the base and defining an interior receptacle wherein the housing further includes an opening 32 in communication with the interior receptacle and a roll of sheet material disposed in the housing wherein a leading end of the roll passes through opening 32.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53 and 54 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ross. Although the Ross reference does not disclose the specifically claimed structure of the roll of sheet material, the Examiner takes official notice that the claimed types of sheet material are commonly dispensed from housings in order to enable a user to effectively dispense sheets when needed. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made that any suitable type of known sheet material, including those claimed, can be dispensed from the Ross device without effecting the overall operation thereof. It is noted that since this same "official notice" type rejection was made in the previous office action, and not contested by the Applicant in the response filed 11/3/06, this claimed feature is now considered to be admitted prior art.

Allowable Subject Matter

Claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39 and 44 allowed.

It is again noted that since claim 1 is no longer generic, any response to this office action attempting to place this case in condition for allowance should include a cancellation of the withdrawn claims or an indication of where the support for the claimed structure in the withdrawn claims can be found with regard to the elected

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embodiment. For example, claims 3-6, 8 and must be canceled before this case can be allowed since the specification has not enabled an embodiment which includes both a dispenser housing having a recess for receiving the first nub of the cap (claim 1) and a dispenser base integrally formed with the dispenser housing (claim 3) or a dispenser housing having a recess for receiving the first nub of the cap (claim 1) and a "barrel portion" (claim 4, the barrel portion is currently part of the embodiment shown in Figure 1 and the elected embodiment is not disclosed as having a "barrel portion"). Further, non-elected claims 57-77 must be canceled prior to this case being allowed.

Response to Arguments

Applicant's arguments filed 3/5/07 have been fully considered but they are not persuasive.

The Applicant contends that the Ross reference is not applicable against claim 45 in that Ross fails to disclose that the nub of the cartridge is complementary to the cartridge recess. As discussed in detail above, however, the nub 12 is clearly shown as being slidably receivable in the recess at the end of element 24.

The Applicant further contends that the Connors reference is not applicable against claim 78. However, as discussed in detail above, the Connors reference discloses the structure as claimed. For example, even though element 16 of Connors has an aperture for the ink tube therethrough, element 16 is still considered to "enclose" the rear end of the writing instrument, at least to some degree, i.e., since the Applicant has not defined the term "enclosed" in the specification, and the specification and

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drawings (of the elected embodiment) do not show the end of the writing instrument being complete enclosed, the term "enclosed" may be interpreted broadly. Further, element 14, as it is capable of holding ink, can be considered an "ink reservoir" which is "enclosed" by element 16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huson Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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David J. Walczak
Primary Examiner
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DJW
4/25/07